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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,583	07/07/2003	Kevin L. Parsons	89535	7657
24628	7590	07/25/2005		
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			EXAMINER WARD, JOHN A	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/614,583	<b>Applicant(s)</b> PARSONS, KEVIN L.	
	<b>Examiner</b> John A. Ward	<b>Art Unit</b> 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05-05-2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 48-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 48-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (US 3,259,428) in view of Tabor (US 5,386,351).

Regarding claim 48, Swartz ('428) discloses a miniature flashlight having a light source 26 having a first lead; second lead extending therefrom and a power source 37 having a first and second side. A housing 34, including a first cover 22, second 23 and a switch 30 operable to closes a circuit of the flashlight (figure 7).

Regarding claim 49, Swartz shows in figure 2 how the first and second cover is adjacent the power source on opposing sides of the power source.

Regarding claim 50, Swartz in figure 2 that the first and second covers have a generally flat shape in cross section that generally parallels a flattened cross section of the power source in an elongated direction of the flashlight.

Regarding claim 53, column 2, and lines 16-31 teaches that the housing and side's covers can be made of any material.

Regarding claim 48, Swartz does not disclose the light source being a light emitting diode.

Regarding claim 48, Tabor ('351) discloses a flashlight having first and second cover 14, 16, a light emitting diode 24 having first lead 26 and second lead 28, a power supply being that of a battery 20 located between both leads of the light emitting diode.

Regarding claims 51, 52 and 54-59, neither Swartz nor Tabor discloses the side covers having different colors, marking or indicia.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add markings or indicia to the sides or surface, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Swartz having the first and second side covers with the flashlight having a light emitting diode in order to provide a flashlight that is light weight and have a light source that will last a longer amount of time over that of conventional incandescent lamps.

Claims 60-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (US 3,259,428) in view of Tabor (US 5,386,351).

Regarding claim 60, Swartz ('428) discloses a miniature flashlight having a light source 26 having a first lead; second lead extending therefrom and a power source 37 having a first and second side. A power source frame 34, including a first cover 22, second 23 and a switch 30 operable to closes a circuit of the flashlight (figure 7).

Regarding claim 61, Swartz shows in figure 2 how the first and second cover is adjacent the power source on opposing sides of the power source.

Regarding claim 62, Swartz in figure 2 that the first and second covers have a generally flat shape in cross section that generally parallels a flattened cross section of the power source in an elongated direction of the flashlight.

Regarding claim 65, column 2, and lines 16-31 teaches that the housing and side's covers can be made of any material.

Regarding claim 60, Swartz does not disclose the light source being a light emitting diode.

Regarding claim 60, Tabor ('351) discloses a flashlight having first and second cover 14, 16, a light emitting diode 24 having first lead 26 and second lead 28, a power supply being that of a battery 20 located between both leads of the light emitting diode.

Regarding claims 63, 64 and 66-71, neither Swartz nor Tabor discloses the side covers having different colors, marking or indicia.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add markings or indicia to the sides or surface, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Swartz having the first and second side covers with the flashlight having a light emitting diode in order to provide a flashlight that is light weight and have a light source that will last a longer amount of time over that of conventional incandescent lamps.

Claim 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (US 3,259,428) in view of Tabor (US 5,386,351).

Regarding claim 72 Swartz ('428) discloses a miniature flashlight having a light source 26 having a first lead; second lead extending therefrom and a power source 37 having a first and second side. A housing 34, including a first cover 22, second 23 and a switch 30 operable to closes a circuit of the flashlight (figure 7).

Swartz shows in figure 2 that the first and second covers have a generally flat shape in cross section that generally parallels a flattened cross section of the power source in an elongated direction of the flashlight.

Regarding claim 72, Swartz does not disclose the light source being a light emitting diode.

Regarding claims 72, neither Swartz nor Tabor discloses the side covers having different colors.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add markings or indicia to the sides or surface, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Regarding claim 72, Tabor ('351) discloses a flashlight having first and second cover 14, 16, a light emitting diode 24 having first lead 26 and second lead 28, a power supply being that of a battery 20 located between both leads of the light emitting diode.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Swartz having the first and second side covers with the flashlight having a light emitting diode in order to provide a flashlight that is light weight and have a light source that will last a longer amount of time over that of conventional incandescent lamps.

Claims 73-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (US 3,259,428) in view of Tabor (US 5,386,351).

Regarding claim 73 Swartz ('428) discloses a miniature flashlight having a light source 26 having a first lead; second lead extending therefrom and a power source 37 having a first and second side. A housing 34, including a first cover 22, second 23 and a switch 30 operable to closes a circuit of the flashlight (figure 7).

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Regarding claim 74 and 75, Swartz shows in figure 2 that the first and second covers have a generally flat shape in cross section that generally parallels a flattened cross section of the power source in an elongated direction of the flashlight.

Regarding claim 73, Swartz does not disclose the light source being a light emitting diode.

Regarding claims 76 and 77, neither Swartz nor Tabor discloses the side covers having different colors.

Regarding claim 73, Tabor ('351) discloses a flashlight having first and second cover 14, 16, a light emitting diode 24 having first lead 26 and second lead 28, a power supply being that of a battery 20 located between both leads of the light emitting diode.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add markings or indicia to the sides or surface, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the flashlight of Swartz having the first and second side covers with the flashlight having a light emitting diode in order to provide a flashlight that is light weight and have a light source that will last a longer amount of time over that of conventional incandescent lamps.

### ***Response to Arguments***


In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has cited case law of 73 USPQ 431 *In re Seid* regarding the ornamentation of a item in this case a flashlight does not provide a mechanical and patentably distinct function. The use of flashlight with various colors and indicia old and well known, see Griffin (US 4,819,140) and Mui et al (US 4,697,228) as evidence.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Ward whose telephone number is 571-272-2386. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571-272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAW  
July 15, 2005



JOHN ANTHONY WARD  
PRIMARY EXAMINER